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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,179	10/30/2001	Brian Pond	05236-1025	7667
7590	12/02/2004		EXAMINER	
Parkhurst & Wandel LLP 1421 Prince Street Suite 210 Alexandria, VA 22314-2805			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 12/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/016,179	POND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on see detailed Office action.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1 and 3-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 34-39 is/are allowed.
- 6) Claim(s) 1,3-6,8-28 and 30-33 is/are rejected.
- 7) Claim(s) 7 and 29 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office action is responsive to communication received 08/31/2004 – Amendment.

Claim 2 has been canceled.

Claims 1 and 3-39 remain pending.

The drawings were received on 08/31/2004. These drawings are acceptable to the examiner for examination.

Applicant notes in his remarks received 08/31/2004 that the prior art reference to Raines, cited within the body of the last Office action, was not identified in a manner that made it easy to access this patent. A further review of the application file wrapper indicates that the FORM-PTO 892 incorrectly noted the U.S. Patent No. for the Raines Patent. The PTO-892, mailed 03/31/2004 lists U.S. Patent to Snyder as 3,815,941. The PTO-892 should instead have identified U.S. Patent to Raines as 3,815,910. A corrected citation for the Raines patent appears in the FORM PTO-892, attached to the current Office action. Any inconvenience to the applicant is sincerely regretted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 4, 5, 6, 8, 9, 10, 11, 16, 17, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica in view of Cochran. The patent to Kubica shows every feature claimed except for explicitly stating that the combined weight of the toe and heel sections comprises at least 80%, as required by claim 1, or 90%, as required by claim 3. In addition, Kubica fails to detail the dimensional features of the cavity and the dampener, as required by claims 4 and 19, respectively. Kubica further fails to detail the specific material make-up required by claims 11 and 18. Note, Kubica indicates that the insert (60) may range from four to thirty grams and that the iron-type club head used may be one of any iron-type club heads from a one-iron to a wedge. See col. 1, lines 59-67 and col. 3, lines 7-27 in Kubica. Typically, the average weight of an iron-type club head is about 200 grams. This fact is supported by, for example, a teaching in Cochran, which shows it to be old in the art to include a weight for a club head that is generally the same as a conventional or commonly found iron-type head. See col. 2, lines 42-51 in Cochran. The Cochran teaching indicates that conventional club heads weight between 4 and 12 ounces (between 113 and 340 grams) for a two-iron, for instance. Assuming an average weight, as mentioned supra, of about 200 grams, and considering that the Kubica club head is perimeter weighted and further considering the negligible weight provided by the insert (60), it is clear that

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the Kubica club head includes at least about 80% and more specifically 90% of the head weight between the combined toe and heel ends. Even, in arguendo, if one argues that Kubica does not imply that 80% - 90% of the head is concentrated in the combined heel and toe areas, the skilled artisan would have found it obvious to provide a higher concentration of weight at the heel and toe ends, merely to increase the moment of inertia. In this regard, Cochran clearly serves as a motivational teaching that the weight at the heel and toe ends should be enhanced to maximize the radius of gyration. As for the remaining limitations in the claims and with respect to the Kubica patent, note that Kubica shows an insert (60) that is made of plastic material. Thus, insofar as claims 5, 6 and 20, the plastic insert clearly serves to increase the natural frequency of the head (claim 5), to dampen a vibration generated in the striking face (claim 6) and for changing a sound emitted by the golf club head (claim 20). Moreover, it is noted that these limitations in claim 5, 6 and 20, respectively, and namely, "for increasing a natural frequency", "for dampening a vibration" and "for changing a sound emitted by the golf club head when a golf ball is struck" are merely functional in nature. As to claims 8 and 9, the insert (60) may weight between four and thirty grams (col. 3, line 14 in Kubica). As to claim 16, Kubica shows an iron-type club head. As to claim 17, note that the insert (60) is secured within the cavity at the rear of the head using epoxy material (col. 3, lines 3 and 4 in Kubica). Here, epoxy is considered to be a dampener connecting the rear insert in the cavity. Regarding claims 4 and 19, the claimed dimensional limitations are not deemed critical, as the size of the cavity including the cavity floor, back and sides along with the dimensions of the dampener material would have

depended upon the size limitations of the club head. In other words, the skilled artisan would have found it obvious to change these parameters as needed depending upon the size or style of club head used. As to claims 11 and 18, while Kubica simply notes that the insert (60) is made of plastic, the skilled artisan would have found it obvious to select any suitable polymer material based upon the characteristics of the material. Note, the Patent laws have long established that the selection of a material to take advantage of its natural properties would have been obvious to one of ordinary skill in the art at the time of the invention. See In re Hopkins 145 USPQ 140.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica in view of Cochran and McGeeney. Kubica in view of Cochran has been discussed above, Kubica, as modified, does not explicitly detail a powder metallurgy process. The skilled artisan would have found it obvious to select a suitable material and associated manufacturing process based upon the availability of materials known in the art and any cost considerations. Note that the teaching reference to McGeeney obviates the use of a powder metallurgy process in the golf club head art, as McGeeney makes use of this process to fabricate at least a portion of the head (col. 5, lines 26-46).

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica in view of Cochran and Buettner. Kubica in view of Cochran has been discussed above. Kubica, as modified, does not expressly state that a vapor deposition is employed on at least a portion of the head. The use of a vapor deposition process using, for example, titanium material as the coating, on a golf club head to impart a tough, hard, low friction and lustrous outward look is obviated by the patent to Buettner

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(see col. 3, lines 40-52). Thus, the skilled artisan would have been motivated to further modify the club head in Kubica using a vapor deposition process to coat the head with an appropriate material for the reasons advanced in Buettner.

Claims 21, 23, 24, 28 and 30 STAND rejected and claims 27 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudell. As to claim 21, note that Rudell includes a heel section, a toe section and a central section that joins the toe and heel sections, with the central portion including a cavity rearward of the front face and containing a rear-insert (17). The front face surface (33) includes a "face-insert" in the form of a wood surface portion (32). As the wood surface portion (32) may be secured via a tongue-and-groove connection, the wood surface portion (32) may clearly be interpreted as a "face-insert". As to claims 23 and 24, reference is made to Figure 4, wherein Rudell clearly shows that the face-insert (32) comprises at least 50% of the surface area of the front face and more particularly between about 45% and 75% of the surface area of the strike face. As to claim 27, since the club head (and the insert, as defined herein) may be made from any one of a number of materials (col. 5, lines 48-58), it is clear that the insert (17) may increase the natural frequency of the head. Moreover, the language in claim 27, "for increasing a natural frequency of the golf club head" is only functional in nature. As to claim 28, the insert (17) is coupled to the back face, rearward of the striking surface. Also, the language in claim 28, "for dampening a vibration generated in the strike face when a golf ball contacts the strike face" is merely functional in nature. As to claim 30, the shaft (13) is positioned within the insert (17). As to claim 32, Rudell shows a putter-style club head.

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Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell.

Though the specific claimed material for the face-insert is not detailed by Rudell, it is noted that Rudell instructs the skilled artisan to fabricate the diverse parts of the club head from any one of a number of well-known materials (col. 5, line 48 through col. 7, line 13). As such, the skilled artisan would have found it obvious to modify the device in Rudell to take advantage of any one of a plethora of available light weight non-metallic materials for the face-insert in order to maintain the weight requirements of the head. Moreover, the selection of a material to take advantage of its natural properties, in this case, the selection of a light weight material, would have been obvious to the skilled artisan based upon the Patent law established by In re Hopkins 145 USPQ 140.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell in view of Fisher. To have modified the device in the cited art reference to Rudell by replacing the face-insert (33) with another face-insert having the claimed Bayshore rebound in order to alter the ball-striking characteristics of the head would have been obvious in view of the patent to Fisher, which shows it to be old in the art of putter heads to include a face portion with a specific ball-impacting rebound factor that may be varied to accommodate the hardness level of the face with which a golfer is most comfortable. See col. 2, lines 24-37 along with col. 8, lines 26-40 in Fisher.

Claims 1, 6, 10, 13, 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell in view of Reiss. The patent to Rudell does not detail specific weight percentages for the toe and heel. Reiss shows it to be old in the art to heavily weight the ends of a putter head, with the weight of the heel and toe making up between

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about 60% and 90% of the weight of the head (col. 1, lines 51-67). Reiss desires to enhance the moment of inertia by concentrating the weight of the head at the extreme toe and heel ends, thereby enlarging the "sweet spot". In view of the patent to Reiss, it would have been obvious to modify the Rudell device to include at least 80% and further at least 90% of the club head weight at the toe and heel ends, the motivation being to increase the size of the sweet spot and increase the club head's resistance to rotation during off-center shots. Regarding the remaining limitations in the claims and with respect to the Rudell patent, note the following: As to claim 1, an alternative interpretation of Rudell, given the broad interpretation of "cavity" in claim 1, finds that Rudell includes a toe portion (21) along with heel portion (19). Central portion (23) extends between the toe and the heel and forms a rearward cavity that contains "insert" (17). As to claim 6, the insert (17) is coupled to the back face of the head, with the back face located opposite to a front face (33). As to claim 10, the head may be made entirely of aluminum (col. 5, lines 48-51). Thus, the insert, as defined above, is formed of aluminum. As to claim 13, note col. 8, lines 25-33, wherein Rudell indicates that a hosel and shaft arrangement may be employed instead of simply a shaft connection. In this manner, the hosel would indeed be positioned in the insert. As to claim 16, Rudell shows a putter-style club head.

Claim 31 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell in view of Buettner. Although Rudell does not expressly state that a vapor deposition is employed on at least a portion of the head, Rudell does imply that any one of a number of finishing processes may be used for the head depending upon the

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material selection thereof. See col. 7, lines 3-14 in Rudell, wherein it is stated that a highly polished appearance for the head is desirable and that an anodized aluminum or other material provided with a suitable surface treatment is preferred. The use of a vapor deposition process using, for example, titanium material as the coating, on a golf club head to impart a tough, hard, low friction and lustrous outward look is obviated by the patent to Buettner (see col. 3, lines 40-52). Thus, the skilled artisan would have been motivated to modify the club head in Rudell using a vapor deposition process to coat the head with an appropriate material for the reasons advanced in Buettner.

Claims 21, 23, 24, 27, 28, 32 and 33 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Ebbing. As to claim 21, note that Ebbing includes all of the recited features including a face-insert (20). As to claims 23 and 24, Figures 1, 2 and 3 in Ebbing clearly show that the face-insert (20) comprises at least 50% of the surface area of the front face and more particularly between about 45% and 75% of the surface area of the strike face. As to claim 27, here again the insert (44) naturally increases the natural frequency of the head, as broadly as claimed. As to claim 28, the insert (44) is coupled to the back face (see Figure 3). As to claim 32, the Ebbing device shows a putter-style club head. As to claim 33, a dampener material in the form of a rubber cushioning may couple the insert to the cavity.

Claim 1 is objected to because of the following informalities: In line 7, the phrase "a cavity having a cavity" appears redundant and is not understood. Appropriate correction is required.

Claims 7 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

At this time, claims 34-39 appear to be allowable over the prior art references of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figures 5 and 9 in Wargo. Mills shows a cavity, of interest. Observe Figures 1 and 2 in Vincent. Glod, Yoneyama and Takeda show iron-type club heads having inserts in the rear portion of the head. Wu shows a putter having a cavity in the back portion.

#### RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 1, 3-6, 8-28 and 30-33 have been considered but are generally moot in view of the new ground(s) of rejection.

It is noted that a review of the applicant's arguments on page 20 of the 08/31/2004 amendment indicates that the applicant is arguing that a cavity floor for receiving a rear insert is now recited in claims 1 and 21. A review of the presently amended claims does not reveal a "floor" as part of claims 1 and 21. Also, note the objection to claim 1, as indicated supra, wherein the language "a cavity having a cavity" is indicated as not being understood. Applicant is respectfully requested to review the cited portion of his last argument and the amended claims so that a clearer response may be made to the present Office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

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November 29, 2004